

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re patent application of:

James A. HOFF

Serial No. 10/602,905

Filed June 24, 2003

CLOSURE ASSEMBLY

)
) Before the Examiner
)
) James N. Smalley
)
) Group Art Unit 3727
)
) October 3, 2006
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James M. Durlacher
Signature

October 3, 2006

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APPELLANT'S REPLY BRIEF

Appellant's Reply Brief
Serial No. 10/602,905
Applicant: James A. Hoff
Group Art Unit 3727
Atty Docket No. 1104-964/RKE-075

I. INTRODUCTORY COMMENTS

The Examiner's Answer was mailed September 11, 2006, and Appellant is allowed two (2) months from that date to file a Reply Brief as a matter of right. Appellant is required to file a Reply Brief to maintain the Appeal in response to an Examiner's Answer that contains a new ground of rejection. Appellant has elected to file this Reply Brief as a matter of right, consistent with the understanding that the Examiner has not presented a new ground of rejection. The only caveat in this regard pertains to the continuing confusion regarding claims 5 and 8 and specifically what claims were and were not intended to be listed by the Examiner in each of the various summary paragraphs regarding the rejection of claims in the last Official Action.

Since the Examiner has stated that there is no error on his part with regard to this claim identification, except for overlooking that claim 18 was canceled, it seems clear that the Examiner has not intended to present any new ground of rejection and Appellant is proceeding on that basis.

The outline and format for this Reply Brief track the section numbering set forth in the Examiner's Answer. Only those sections where Appellant desires to reply are being listed, beginning with Section No. 6.

II. APPELLANT'S REPLY TO EXAMINER'S ANSWER

(6.) Grounds of Rejection to be Reviewed on Appeal.

The confusion over what claims are part of what grounds of rejection persists. While it may not matter, depending on the final decision by the Board, there is something to be said for accuracy.

At the start of paragraph No. 3 of the November 30, 2005 Official Action, the Examiner lists claims 1, 8-9 as being rejected under 35 U.S.C. §102(b) as being anticipated by Bradshaw et al., US 4,105,135, in reference to Baughman, US 5,971,189. Then, on page 3 of this Official Action, beginning with the first paragraph, the Examiner specifically mentions claim 1 with a more detailed discussion. Then, in the second paragraph, the Examiner specifically refers to claims 5 and 9 and only claims 5 and 9. In this second paragraph, the Examiner discusses the “flat surface” and it should be noted that there is a reference to a “flat surface” in claims 5 and 9, though not in claim 8. Based upon the text of this second paragraph, it seemed entirely appropriate that the Examiner would be discussing claims 5 and 9 in the context of referring to a “flat surface”. The Examiner never makes any comment regarding claim 8, nor any comment regarding the unitary construction recited in claim 8. If, as the Examiner states, the rejection pertains to claims 1, 8 and 9, why does he discuss claim 5, the reference to a flat surface, and never discusses claim 8 or its recited limitation?

It was logical for Appellant to assume that the “1 and 8-9” claim listing was incorrect in that the Examiner discussed claims 1, 5 and 9 and did not discuss claim 8. If claim 8 is not

covered by this first ground of rejection, then it is not covered in the Office Action. The fact that the Examiner now brings claim 8 into the Official Action, is that considered a new ground of rejection? It is assumed that this is not a new ground of rejection based upon the Examiner's statements and assertions in the Examiner's Answer.

(10.) Response to Argument.

(A.) First Grounds.

The Examiner makes a number of generalizations and assumptions that are not accurate or are at least incomplete. There are also a number of important structural aspects that are embodied in claim 1 based upon its selected terminology and how claim 1 would be interpreted based upon the specification. Perhaps most importantly, the Federal Circuit decision in Phillips v. AWH Corp., 415 F.3d 1301 (Fed. Cir. 2005)(en banc), makes it clear that the specification is the principal resource in order to ascertain the meaning of a claim term as it is used by the inventor in the context of the entirety of the invention.

Claim 1 recites a "closing" plug for receipt by a threaded "flange" wherein the closing plug is constructed and arranged so that its axially-protruding projections abut against a surface of the drum end in order to limit the threaded advancement of the plug into the flange. The specification makes it clear that the type of containers being described are large, industrial, metal drums for over-the-road shipments (page 1, lines 22-25). These types of metal drums include a drum end that does not have a sufficient material thickness for internal threading of the required dispensing opening. An internally-threaded "flange" is assembled into the drum end for this purpose. Changing all of this to some type of molded plastic, unitary construction so that the

“flange” could be integrated into the molding of the container is not an option. There are numerous cost, size, strength, material compatibility, and re-use issues that preclude the use of plastic. This is obvious when tens of millions of these large metal drums are fabricated and/or refurbished every year. While plastic may be suitable for other styles of containers and smaller containers, those types are not disclosed in the subject application. The Examiner’s idea of integrally molding a plastic flange into a plastic container, as if that equates to the Baughman reference, totally ignores the fact that the specification is directed to a metal container and a separate, internally-threaded flange that is assembled into the drum end.

The claim 1 preamble specifically refers to “a threaded flange” that is “assembled” into a “drum end”. If all of this was irrelevant, the preamble would have only recited a drum end having an internally-threaded opening. As for whether a preamble term or element is considered to be a claim limitation, the case law is clear. The preamble is regarded as limiting if it recites essential structure that is important to the invention or necessary to give meaning to the claim, NTP Inc. v. Research in Motion Ltd., 418 F.3d 1282 (Fed. Cir. 2005). When the limitations in the body of the claim “rely upon or derive antecedent basis from the preamble, then the preamble may act as a necessary component of the claimed invention”. Eaton Corp. v. Rockwell Int’l Corp., 323 F. 3d 1332 (Fed. Cir. 2003).

The use of plastic and a unitary construction are not options and are not disclosed nor suggested as options. Instead, claim 1 specifically refers to the threaded flange and the preamble is required to provide the antecedent basis for this claim language. Claim 1 also recites the drum end and the abutment of the projections against the drum end. Not only does the preamble recite an essential structure, i.e., the abutment surface, but the preamble provides the antecedent basis

for this claim language. These aspects of the preamble cannot be ignored and are important to a full understanding of the claim. It is improper to simply ignore these important structural aspects and inject hindsight and speculation into the analysis by assuming an integrally molded, plastic construction is equivalent, since it is not.

Anyone of ordinary skill in this art would be knowledgeable about the D.O.T. inspection standards and the reference terminology of “drum end” and “flange”. Further, all of this must be evaluated in view of the Phillips v. AWH Corp. decision.

Further, the concept of “closing” (closing plug) means that there is in fact complete “closing” of the opening, i.e., no leakage. This requires that the requisite torque be achieved in order to properly compress the sealing gasket and meet all D.O.T. requirements, including the requisite threaded engagement. The term “closing” means something that closes or shuts off. A “plug” is a piece of material or construction that is used to stop up a hole or to fill a gap. The understanding of a plug is that it only becomes a “plug” once it is used to stop up a hole or to fill a gap. Simply placing a threaded component on a table top or counter top does not make that threaded component a plug until it is actually placed in use. If it is not used to stop up a hole or to fill a gap, it may be nothing other than a paperweight. Considering this aspect of the disclosed structure, claim 1 was written to make it clear that the plug is constructed and arranged to be a closing plug and this in turn brings the flange and the drum end into the claim.

A plug that is not fully threaded into the flange cannot achieve the requisite “closing” and thus it does not become a “closing plug”. A plug that is over-torqued simply causes the sealing gasket to be over-compressed (axially), such that it cannot provide adequate resiliency and

flexibility for sealing and thus this “plug” is not a closing plug. This concern was addressed on page 11 of the application, in lines 1-3.

Claim 1 requires a plug and a cooperating receiving structure of a flange assembled into a drum end such that there is a drum end surface for the projections to abut against and thereby create a “closing” plug. The Bradshaw et al. device does not provide the abutment and thus there is no way to tell if the plug is over-tightened or over-torqued to the degree that the gasket (9) is over-compressed. There is also no way to tell whether the Bradshaw et al. device is under-tightened or under-torqued.

Further, the Bradshaw et al. device uses the undersurface (6a) of the plug lip (6) for abutment against flange bead (18). The essence of the Bradshaw et al. disclosure is completely different from the claimed invention. The only way to create some theory about scallops (8) being used for, or even capable of being used for, abutment against a drum end is to rely heavily on hindsight knowledge.

Further, the Examiner’s approach ignores the “closing” requirement and broadly assumes that all one needs is a threaded component that goes into some threaded opening and, at some point in the process, the projection abuts up against some surface. The Examiner has failed to establish or explain how all of the requirements of claim 1 can be met by this combination.

It is not clear what the Examiner intends by his phrase “in reference to Baughman US 5,971,189”. The Examiner states that the Bradshaw et al. plug could be “applied” to another threaded flange, such as Baughman. However, the concept of “applied” is never explained and Baughman does not provide a threaded flange. If the Bradshaw et al. lip (6) extends radially such that scallops (8) are outside of axial wall (32) of Baughman, then other issues result. For

example, under this particular construction, the same abutment result that is now detailed in Bradshaw et al. would occur with a combination of the Bradshaw et al. plug and the Baughman structure. More specifically, an attempt to combine Bradshaw et al. and Baughman could result in the underside surface (6a) of Bradshaw et al. abutting up against top surface (34) of the axial wall (32) of Baughman. Under this arrangement, there is, once again, a failure to achieve or create the claimed invention. There is no basis to assume that the Bradshaw et al. plug would fit inside of the axial wall (32) of Baughman. The only way to ensure what the Examiner is trying to create is to chop off axial wall (32) or perhaps shrink the Bradshaw et al. plug so that it is substantially smaller. Obviously, shrinking the plug would shrink the threaded body so at that point we probably also have to shrink the threads of the Baughman opening.

Even if the projections of Bradshaw et al. are capable of stopping threaded advancement, how would anyone be able to confirm that the plug is in fact constructed and arranged as a closing plug? We have no way to tell if the plug is properly threaded into a flange opening with the requisite torque to achieve not only proper threaded engagement but also proper gasket compression so that the plug actually becomes a closing plug.

Perhaps one of the more interesting statements by the Examiner is found on page 4, in lines 7 and 8 of the Examiner's Answer. The Examiner indicates that in order to try and make his theory work, he needs to be "given an appropriately dimensioned drum opening with an annular flange about the threaded opening such as that of Baughman". Since Baughman does not include an annular flange, this particular statement sounds as if the Examiner also wants to modify Baughman. This statement also assumes that we can creatively fabricate an appropriately-dimensioned drum opening, though none has been provided nor designed. This

statement also ignores the fact that we need to have a drum end surface for abutment at that proper point in the threaded engagement such that the plug performs the closing function. Given what is disclosed by Bradshaw et al., why is the Examiner looking for an appropriately-dimensioned drum opening? This would seem to be the ultimate in speculation and the use of hindsight knowledge.

(C.) and (D.) Third and Fourth Grounds.

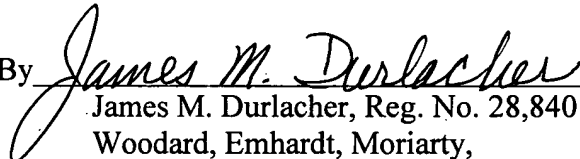
The prior comments and analysis regarding the metal drum construction and the requirement for a separate flange component installed into the drum end are incorporated by reference and repeated herein for these third and fourth grounds. It is not acceptable to replace the metal drum construction and separate flange, as defined by the specification, with a molded plastic construction. The molded construction of Baughman does not provide “a threaded flange connected to a drum end” as the claims require.

III. CONCLUSIONS

The Board of Patent Appeals and Interferences is respectfully requested to acknowledge the patentability of claims 1-5, 7-9, and 13-17.

Although no fee is believed to be required for submission of Appellant's Reply Brief, please charge any fees which are due to Deposit Account No. 23-3030.

Respectfully submitted,

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